

### **REMARKS**

This Amendment is in response to the Final Office Action mailed May 29, 2007. Claims 1-25, 30, 31, and 35-37 were rejected. Claims 2, 9, 14, and 21 have been amended. No claims have been added or canceled. Thus, claims 1-25, 30, 31 and 35-37 are pending. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 112***

The Examiner rejects claims 2, 9, 14 and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 2 and 14 to recite “electronic device,” instead of “local network device.” Furthermore, Applicants have amended claims 9 and 21 to recite “private local network search” instead of “local network search.” In light of these amendments, Applicants submit that the limitations claimed within claims 2, 9, 14, and 21 have a sufficient antecedent basis. Therefore, Applicants respectfully requests that the Examiner withdraw the rejection of claims 2, 9, 14 and 21 under 35 U.S.C. § 112, second paragraph.

#### ***Rejection Under 35 U.S.C. § 102***

The Examiner rejects claims 1-7, 9-10, 12-19, 21-22, 24-25, 30-31 and 35-37 under 35 U.S.C. § 102(e) as being anticipated by Singhal (U.S. Patent No. 6,370,527). Applicants respectfully disagree.

Singhal describes a meta-search engine device for searching distributed network environments (Singhal, Abstract; Column 2, lines 18-34). The meta-search engine sends search requests to a plurality of search engines and compiles the results (Singhal, Column 2, lines 35-

58). The search is performed on storage devices connected to a network, or a combination of networks, where the storage devices “store information and files that may be of interest to a user” (Singhal, Column 3, lines 30-40; Column 4, lines 45-57). The search engine devices return results, which are correlated with each other, ranked, and displayed to a user (Singhal, Column 6, lines 1-28).

The Applicants claim, in part, a private local network search where the private local network contents includes “one or more of the documents [] saved in the absence of an explicit command by a user to save the electronic documents, but saved in response to another user specified function associated with the electronic documents” (See claim 1). In one embodiment, the Applicants refer to such documents as “unconsciously captured documents,” or those documents that do not require explicit actions of a user to save documents (*See, for example*, Specification, page 9, line 19 to page 10, line 4). Applicants respectfully submit that the concept of “unconsciously captured documents” as claimed by the Applicants, and as would be understood by one skilled in the art, is completely absent from Singhal.

The Examiner states:

The specification states on page 13, lines 3-6, that “in general, unconsciously capture refers to FMA 150, or other device, automatically capturing documents processed by the network 100 or devices coupled to network 100 without user intervention”. Based on this definition, it is clear that any device that performs storing or caching without a user specifically directing the device to perform this action, reads on t his broad limitation.

(Final Office Action, mailed May 29, 2007, page 13).

The Examiner then notes that “the controller 200 [of Singhal] receives the results of each of the search engine devices 140-160 and stores then in memory” (Final Office Action, mailed May 29, 2007, page 14 *citing* Singhal, column 6, liens 38-40).

However, the passage of Singhal cited by the Examiner actually discusses a user directly causing a controller to save search results based on an explicit command of the user. When a user initiates a search request for the controller, the controller saves the search results in response to fulfilling the request. Thus, the controller described by Singhal is capturing exactly that which was requested by a user, search results.

Applicants claims, however, are directed to integrating search results for unconsciously captured documents, with documents available via a public network. Furthermore, the unconsciously captured documents are documents saved, in a private network, when a function unrelated to saving the document is requested. That is the unconscious capture of a document is the process by which “one device, requests an archiving device, such as data storage device 140, to archive a document” (Specification, page 9, line 19 to page 10, line 5). In one embodiment, an exemplary function resulting in the unconscious capture of a document is a user requests that a document be printed. The print request, in the example, would then result in the document being archived and made searchable, as an unconsciously captured document. This concept of searchable unconsciously captured documents, as claimed by the Applicants and as would be understood by one skilled in the art, is completely absent from Singhal.

Therefore, for at least the reasons discussed above, the Applicants submit that Singhal fails to teach or even suggest the elements claimed by the Applicants, and fails to anticipate claim 1.

Claims 2-7, 9, 10, 12 depend from claim 1. Claims 14-19, 21, 22 and 24 depend from claim 13. Claims 30, 31 and 35-37 depend from claim 25. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7, 9, 10,

12, 14-19, 21, 22, 24, 30, 31 and 35-37 are not anticipated by Singhal for at least the reasons set forth above.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-7, 9-10, 12-19, 21-22, 24-25, 30-31 and 35-37 under 35 U.S.C. § 102(e) as being anticipated by Singhal.

***Rejection Under 35 U.S.C. § 103***

The Examiner rejects claims 11 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Singhal as applied to claims 1, 7, 13 and 19, above, and further in view of Rakavy, et al. (U.S. Patent No. 5,913,040).

Claim 11 depends from claim 1 and claim 23 depends from claim 13. Rakavy is cited to teach a search report having an advertisement selected based on the search results (Final Office Action, page 8, mailed July 18, 2006). However, whether or not Rakavy discloses the selection of advertisements, Rakavy does not cure the deficiencies of Singhal set forth above. Therefore, neither Singhal nor Rakavy, alone or in combination, teach or suggest the invention as claimed in claims 11 and 23.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 11 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Singhal in view of Rakavy.

The Examiner rejects claims 8 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Singhal as applied to claims 1, 7, 13 and 19, above, and further in view of Nasr, et al. (U.S. Patent No. 6,263,332).

Claim 8 depends from claim 1, and claim 20 depends from claim 13. Nasr is cited to teach a search report as either HTML or XML (Final Office Action, page 9, mailed July 18, 2006). However, whether or not Nasr discloses HTML and/or XML search results, Nasr does

not cure the deficiencies of Singhal set forth above. Therefore, no combination of Singhal and Nasr can teach or suggest the invention as claimed in claims 8 and 20.

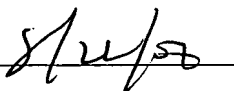
Applicant respectfully requests that the Examiner withdraw the rejection of claims 8 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Singhal in view of Nasr.

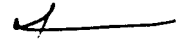
***Conclusion***

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

Date: \_\_\_\_\_



  
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